

REMARKS

Claims 1-60 and 66-68 are pending. Claims 1, 3, 4, 31, 33, and 66 have been amended. No new matter has been added by way of this amendment. Reconsideration of the application is requested.

Applicants acknowledges the finality of the election/restriction requirement that was entered by the Examiner in the Office Action mailed on March 11, 2003. Applicants' response to the election requirement was an election of Group I, claims 1-60 and 66-68, and Species I, Figs. 2a, 2b. According to the Examiner, claims 1-10, 27, 28, 30-40, 57-58 and 66-68 relate to Species I, Figs. 2a, 2b. The Examiner has withdrawn claims 11-26, 29, 41-56, 59 and 60, asserting that these claims are drawn to Species IV that illustrates a ring embodiment for the switch for the hand piece. In response to the finality of the requirement, Applicants wish to direct the Examiner's attention to §806.04(d) of the M.P.E.P. which states:

“Once a claim that is determined to be generic is allowed, all of the claims drawn to species in addition to the elected species which include all the limitations of the generic claim will ordinarily be obviously allowable in view of the allowance of the generic claim, since the additional species will depend thereon or otherwise include all of the limitations thereof.”

Applicants also wish to draw the Examiner's attention to §809.02(c) of the M.P.E.P. which states:

“Upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all of the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141.”

According to the Examiner, claim 1 is generic. Therefore, Applicants respectfully wish to point out that upon the allowance of generic claim 1, then the withdrawn claims that depend therefrom should also be allowable and should pass to issue with the generic claim.

Claims 1-10, 27, 28, and 30 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

According to the Examiner, "it is unclear what is meant by 'if a **monitored pressure** on the switch' and how it relates to the system for implementing surgical procedures. Apparently, the applicant was referring to 'a sensor' in claim 66." With respect to this rejection, the following is noted. It is a well settled principle that where the meaning of a term in a claim is not clear, resort may be had to the specification to determine the meaning thereof. In this regard, Applicants respectfully assert that the specification provides a clear meaning of the term "if a monitored pressure on the switch." For example, this aspect of the invention is discussed on page 9, lines 15-18 of the specification. It is also discussed on page 14, lines 1-7 and 12-20 of the specification. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Claims 1-10, 27, 28, 30-40, 57-58, and 66-68 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,026,387 to *Thomas* in view of U.S. Patent No. 4,979,952 to *Kubota et al.* In response to this ground of rejection, Applicants have amended independent claims 1, 31, and 66 to more clearly recite those features of the invention that distinguish it from the cited references. Accordingly, for the reasons set forth hereafter, Applicants respectfully submit that all claims of record now distinguish over the cited references.

Claims 1, 31, and 66 have been amended to recite the limitation “the handpiece operating at a level proportional to a sensor monitored pressure value on the finger-operated switch.”

U.S. Patent No. 5,026,387 to *Thomas* relates to methods and apparatus for facilitating the performance of surgical procedures such as cauterization of large blood vessels or simultaneous soft tissue dissection, and coagulation of small vessels through the use of a precisely controlled ultrasonically vibrating scalpel (see col. 1, lines 9-14). However, this reference fails to disclose the limitation “the handpiece operating at a level proportional to a sensor monitored pressure value on the finger-operated switch,” as set forth in amended independent claims 1, 31, and 66.

U.S. Patent No. 4,979,952 to *Kubota et al.* relates to an ultrasonic vibration treatment apparatus, which can detect the vibrating state and immediately control the vibration of an ultrasonic vibration treatment device. This reference, however, fails to cure the deficiency of the *Thomas* patent. Specifically, *Kubota et al.* also fails to disclose the limitation “the handpiece operating at a level proportional to a sensor monitored pressure value on the finger-operated switch,” as set forth in amended claims 1, 31, and 66.

Set forth in the Office Action is the statement that:

“Thomas discloses a system for implementing surgical procedures including: an ultrasonic surgical handpiece (2) has an end-effector (3), a generator (1) controls the handpiece, wherein an electrical connection (fig. 1) connects the handpiece and the generator. The generator (1) sends a drive current to drive the handpiece (2) which imparts longitudinal movement to the end-effector (3); and wherein a finger-operated switch (6a) provides on a housing of the handpiece (2), the switch activates the handpiece at a first power level. However, Thomas does not disclose if a monitor pressure on the switch reaches a high threshold and deactivating the handpiece if the monitor pressure reaches a low threshold. Kubota et al teach

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'pressure-activated' switch (Figs 1, 2, 8 and col. 4, lines 65-67, col. 5, lines 1-10, col. 7, lines 56-68).

It would have been obvious to one having ordinary skill in the art at the same time the invention was made to modify Thomas by adding a 'pressure-activated' switch as taught by Kubota et al in order to provide sufficient pressure activated switch which makes the device more assessable for the user. Furthermore, it is noted that such a 'pressure-activated' switch is merely a common switch activated by the pressure of a user's finger and deactivated by the release of the user finger."

However, Applicants respectfully assert that the combination of the *Thomas* and *Kubota* et al. patents do not arrive at the present claimed invention. That is, in the case of the claimed invention, the switch provides multi-level activation and operation, where various levels of applied pressure determine the operation of the handpiece. In accordance with the magnitude of the finger pressure, the output as monitored by the sensor causes the handpiece to be "on" or "off", operating with a power level proportional to the finger pressure as applied to the switch. For instance, after initial activation of the handpiece ("on"), a very low pressure that is applied to the switch enables low power operation of the handpiece. A somewhat higher pressure that is then applied to the switch enables operation of the handpiece at a higher power level, without excessive finger pressure fatigue of a human operating the handpiece.

In contrast, the switch as taught in the *Kubota* et al. patent causes the ultrasonic vibrator to be energized when fingers are applied to the finger application pieces and the ultrasonic treatment device is moved forwardly (see col. 5, lines 5-10). This is a simple on/off operation and therefore does not include the continuous variable power levels, as set forth in the present invention and claimed.

In sum, the *Thomas* and *Kubota* et al. references, whether considered individually or in combination, fail to teach or suggest the limitation "the handpiece operating at a level

proportional to a sensor monitored pressure value on the finger-operated switch,” as set forth in amended independent claims 1, 31, and 66. Therefore, Applicants respectfully assert that these claims are patentable over the combination of the cited references, and a notice to that effect is earnestly solicited.

In view of the patentability of amended independent claims 1, 31, and 66 for the reasons set forth above, dependent claims 2-10, 27, 28, 30, 32-40, 57, 58, 67, and 68 are also patentable over the cited references.

In light of the foregoing amendments and remarks, this application should be in condition for allowance. Early passage of this case to issue is respectfully requested. However, if there are any questions regarding this Response, or the application in general, a telephone call to the undersigned would be appreciated since this would expedite the prosecution of the application for all concerned.

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Respectfully submitted,

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